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23389 7590 02/27/2008 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* TAIRA HANAOKA and AKIRA SAKAI
9

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11 Appeal 2007-2645
12 Application 09/748,843
13 Technology Center 3600
14

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16 Decided: February 27, 2008
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19 Before HUBERT C. LORIN, ANTON W. FETTING, and
20 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.
22
23

24 DECISION ON APPEAL
25

26 STATEMENT OF CASE

27 Taira Hanaoka and Akira Sakai (Appellants) seek review under
28 35 U.S.C. § 134 of a final rejection of claims 1 and 3-14, the only claims
29 pending in the application on appeal.

30 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
31 (2002).

1 We AFFIRM.

2 The Appellants invented a portable information terminal apparatus
3 which reads a URL written on a printed matter, obtains web contents
4 corresponding to the read URL from a web server via a communication
5 network such as the internet, and displays the web contents (Specification
6 1:5-10).

7 An understanding of the invention can be derived from a reading of
8 exemplary claim 1, which is reproduced below [bracketed matter and some
9 paragraphing added].

10 1. A portable information terminal apparatus comprising:
11 [1] a display element;
12 [2] a communication element;
13 [3] a reading element which reads access destination
14 information indicated on a printed matter,
15 said reading element including
16 a scanner which reads an image on said printed
17 matter and
18 an extraction element which extracts said access
19 destination information included in said image;
20 [4] a memory which stores said image;
21 [5] a control element which
22 connects to an access destination corresponding to said
23 access destination information through said
24 communication element,
25 receives contents from said access destination, and
26 executes a browser for displaying said received contents
27 on said display element,
28 [6] wherein said image stored in said memory

[a] is displayed on said display element
[b] as a bookmark image
[c] associated with said access destination information.

This appeal arises from the Examiner's Final Rejection, mailed August 23, 2005. The Appellants filed an Appeal Brief in support of the appeal on August 16, 2006. An Examiner's Answer to the Appeal Brief was mailed on December 1, 2006. A Reply Brief was filed on January 23, 2007. The Appellants presented oral arguments at a hearing on January 20, 2008.

PRIOR ART

The Examiner relies upon the following prior art:

Schena	US 6,546,418 B2	Apr. 8, 2003
Dougherty	US 6,587,859 B2	Jul. 1, 2003

REJECTION

Claims 1 and 3-14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Schena and Dougherty.

ISSUE

The issue pertinent to this appeal is whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1 and 3-14 under 35 U.S.C. § 103(a) as unpatentable over Schena and Dougherty.

The pertinent issue turns on whether the art applied describe or suggest storing a bookmark image.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure contains no lexicographic definition of “bookmark.”

02. The ordinary and customary meaning within the context of a computer environment of “bookmark” is a record of the address of a file enabling quick access by a user.¹

Schena

03. Schena is directed to managing a domain name service involving scanning a machine-readable code containing a link information corresponding to the provider information from an object and storing the machine-readable code in a memory. The link information is then extracted from the machine readable code in the memory. User input corresponding to the provider information is also obtained and stored in the memory. The link information and the user input information are then sent to a portal server which selects a multimedia information sequence corresponding to the link information and the user input information. The multimedia information sequence is then sent to the receiver (Schena 2:25-46).

¹ *Online Compact Oxford English Dictionary*
http://www.askoxford.com/concise_oed/bookmark.

1 04. Schena portrays an embodiment in which the scanner and
2 reception equipment are integrated. This embodiment includes a
3 display, communications equipment, a scanner that reads printed
4 information, memory, and control over the scanning, and access to
5 a destination designated by the contents of information in the
6 scanned image (Schena Fig. 3).

7 05. Schena's scanner may scan and process, scan and hold, or scan
8 and display. The scanner may also allow copying of the code for
9 backup or review and edit (Schena 9:56-59).

10 *Dougherty*

11 06. Dougherty is directed to printable interfaces including encoded
12 images, referred to as linkmarks and multicons, provide both
13 machine and human readable information. The human readable
14 information indicates to the user the nature of the machine
15 readable information, and the machine information enables a user
16 to link to and control computer system (Dougherty 1:19-27). If the
17 machine readable information is a web URL, the system navigates
18 to that URL (Dougherty 2:66 – 3-8).

19 07. Encoded within Dougherty's linkmark is information that the
20 computer system can use to open, access or implement a computer
21 implemented process such as a computer application, a web page,
22 or a web site. In certain embodiments, information encoded on the
23 linkmark may include a uniform resource locator (URL) that
24 directs to a particular web page or web site located on the Internet.
25 In other embodiments, information encoded on the Linkmark may

1 include a particular document available upon the computer
2 system, the computer implemented process in this case being the
3 application which must execute in order to access the particular
4 document. Certain linkmarks are multicon linkmarks which, in
5 addition to encoded machine readable information, provide human
6 readable information indicating to a viewer the nature, function, or
7 capability of the encoded machine readable information
8 (Dougherty 4:55 – 5:4).

9 *Facts Related To The Level Of Skill In The Art*

10 08. Neither the Examiner nor the Appellants has addressed the level
11 of ordinary skill in the pertinent arts of tracking items and data
12 formatting. We will therefore consider the cited prior art as
13 representative of the level of ordinary skill in the art. *See Okajima*
14 *v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he
15 absence of specific findings on the level of skill in the art does not
16 give rise to reversible error ‘where the prior art itself reflects an
17 appropriate level and a need for testimony is not shown’”)
18 (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755
19 F.2d 158, 163 (Fed. Cir. 1985).

20 *Facts Related To Secondary Considerations*

21 09. There is no evidence on record of secondary considerations of
22 non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364, (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily)

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

1 *Obviousness*

2 A claimed invention is unpatentable if the differences between it and
3 the prior art are “such that the subject matter as a whole would have been
4 obvious at the time the invention was made to a person having ordinary skill
5 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct.
6 1727 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

7 In *Graham*, the Court held that that the obviousness analysis is
8 bottomed on several basic factual inquiries: “[(1)] the scope and content of
9 the prior art are to be determined; [(2)] differences between the prior art and
10 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
11 in the pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex*
12 *Inc.*, 127 S.Ct. at 1734. “The combination of familiar elements according to
13 known methods is likely to be obvious when it does no more than yield
14 predictable results.” *KSR*, at 1739.

15 “When a work is available in one field of endeavor, design incentives
16 and other market forces can prompt variations of it, either in the same field
17 or in a different one. If a person of ordinary skill in the art can implement a
18 predictable variation, § 103 likely bars its patentability.” *Id.* at 1740.

19 “For the same reason, if a technique has been used to improve one
20 device, and a person of ordinary skill in the art would recognize that it would
21 improve similar devices in the same way, using the technique is obvious
22 unless its actual application is beyond his or her skill.” *Id.*

23 “Under the correct analysis, any need or problem known in the field
24 of endeavor at the time of invention and addressed by the patent can provide
25 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

ANALYSIS

Claims 1 and 3-14 rejected under 35 U.S.C. § 103(a) as unpatentable over Schena and Dougherty.

The Appellants argue claims 1 and 6 as a group.

Accordingly, we select claim 1 as representative of the group.
37 C.F.R. § 41.37(c)(1)(vii) (2006).

The Examiner found that both Schena and Dougherty describe scanning an image that contains link information and extracting the link information.

The Examiner found that Schena describes the scanner explicitly and that the scanner and receiver could be combined in a single unit. The Examiner found that Dougherty described the scanned images as containing both links such as internet URL's and human readable information. The Examiner implicitly found that one of ordinary skill would have understood the benefits of extracting such human readable information in Dougherty and applied that feature, along with storage, to Schena for the purpose of allowing a user to revisit web contact as taught by Schena (Answer 4-5).

The Appellants contend that Schena fails to describe adding human readable information to its link information (Br. 5:Bottom ¶) and that Dougherty fails to describe how its multicons and linkmarks could be used to create bookmark images (Br. 6:Top ¶). The Appellants further argue that merely collecting links does not create bookmarks, but that images, titles or descriptive text would have to be added (Br. 6:Bottom ¶). The Appellants conclude that it would not have been obvious to create a bookmark image from the combined teachings of Schena and Dougherty (Br. 7:Top ¶).

1 We disagree. Schena is directed toward a system that scans printed link
2 information, and extracts and accesses that link (FF 03). As such, Schena
3 describes an embodiment containing elements [1]-[5] of claim 1 (FF 04).
4 Schena also describes displaying a stored image of the scanned image (FF
5 05).

6 While we agree with the Appellants that Schena describes entering
7 human readable information by a user rather than scanning such in with an
8 image (FF 03), we find that Dougherty describes scanning an image that
9 contains both machine readable link information and human readable
10 information (FF 06). The Appellant is simply attacking the references
11 separately, even though the rejection is based on the combined teachings of
12 the references. Nonobviousness cannot be established by attacking the
13 references individually when the rejection is predicated upon a combination
14 of prior art disclosures. See *In re Merck & Co. Inc.*, 800 F.2d 1091, 1097
15 (Fed. Cir. 1986).

16 Since Schena and Dougherty describe elements [1]-[5], and describe
17 storing an image containing link information, the issue is reduced to whether
18 a bookmark image would have been a predictable variation of the image so
19 stored. The combination of familiar elements according to known methods
20 is likely to be obvious when it does no more than yield predictable results.
21 *KSR*, 127 S. Ct. at 1739. We first must construe the limitation of a
22 bookmark image. The Specification contains no lexicographic information,
23 but the usual and customary definition of a bookmark within a computer
24 context is that of a record of the address of a file enabling quick access by a

1 user (FF 01 & 02). We therefore construe a bookmark image as an image
2 that contains an address of a file enabling quick access by a user.

3 Both Schena and Dougherty describe scanning such images (FF 03 &
4 07). Schena describes storing such an image (FF 05). Although the
5 Appellants argue that a bookmark must also contain human readable
6 information, this is simply not a requirement of a bookmark, and the
7 Appellants have pointed to no evidence otherwise. But even were human
8 readable information required, this is clearly included with Dougherty's
9 multicon linkmark (FF06). Thus, the Appellants have not sustained their
10 burden of showing that the Examiner erred in rejecting claims 1 and 6.

11 The Appellants argue that the dependent claims 3-5 and 7-14 are
12 patentable for the same reason as claim 1. Thus, the Appellants have failed
13 to show the Examiner erred in the rejection of these dependent claims for the
14 same reasons as with claim 1, *supra*.

15 The Appellants have not sustained their burden of showing that the
16 Examiner erred in rejecting claims 1 and 3-14 under 35 U.S.C. § 103(a) as
17 unpatentable over Schena and Dougherty.

18 CONCLUSIONS OF LAW

19 The Appellants have not sustained their burden of showing that the
20 Examiner erred in rejecting claims 1 and 3-14 under 35 U.S.C. § 103(a) as
21 unpatentable over the prior art.

22 On this record, the Appellants are not entitled to a patent containing
23 claims 1 and 3-14.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1 and 3-14 under 35 U.S.C. § 103(a) as unpatentable over Schena and Dougherty is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

vsh

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